

REMARKS

I. Status of the Claims

Applicants submit this response in reply to the Office Action dated February 5, 2009. Claims 1, 2, 6-27, 31-50, 52-65, and 87-94 are currently pending in this application, with claims 1, 26, 50 and 91 being independent. By this Amendment, new claims 95-103 have been added. The new claims are fully supported by the application as originally filed, and no new matter has been entered.

II. 35 U.S.C. § 103(a) Rejection

In the Office Action, claims 1, 2, 6-27, 31-50, 52-65, and 87-94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 01/30242 A1 to Paternuosto ("Paternuosto") in view of U.S. Patent No. 4,763,669 to Jaeger ("Jaeger"). Applicants respectfully traverse the rejection, because the Examiner has not established a *prima facie* case of obviousness.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citations omitted).

When evaluating claims for obviousness under 35 U.S.C. § 103, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (internal citations omitted). Furthermore, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.02(VI) (internal citations omitted). Here the Examiner has not established a *prima facie* case of obviousness because the claimed invention as a whole would not have been obvious in view of Paternuosto and Jaeger as a whole.

A. Independent claims 1 and 26

Independent claim 1 recites an end effector assembly for obtaining multiple tissue samples comprising, among other things, “wherein the holder is configured to receive both the cutting portion and the storage portion, wherein the holder has a groove for receiving both a protrusion on the cutting portion and a protrusion on the storage portion.” Independent claim 26 includes similar recitations.

In utilizing Paternuosto as the primary reference to reject independent claims 1 and 26, page 2 of the Office Action points to front rim 12 of Paternuosto as corresponding to the claimed “cutting portion,” half-shell 10b as corresponding to the claimed “holder,” and container element 22 as corresponding to the claimed “storage portion.” The Office Action also asserts that the hole in base wall 14 of half-shell 10b, as shown in Fig. 9, corresponds to the claimed groove. See the lip within the perimeter of the hole in base wall 14. Even assuming that these relationships are correct, which Applicants do not necessarily concede, Paternuosto fails to disclose, teach, or otherwise suggest that the alleged groove “receiv[es] both a protrusion on the cutting

portion and a protrusion on the storage portion,” as required by independent claims 1 and 26.

1. **Nerwin does not support the conclusion that it would have been obvious to make the front rim and half-shell of the Paternuosto device separate elements**

Page 2 of the Office Action acknowledges that the alleged groove of Paternuosto does not receive a protrusion on the cutting portion. Specifically, the Office Action states, “[s]ince the cutter and holder of Paternuosto are integral, Paternuosto does not teach that the cutting portion has a protrusion for being received on the holder.” See page 2 of the Office Action. The Office Action, asserts, however, that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cutter and holder separate, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 U.S.P.Q. 177 [(Bd. Pat. App. & Int. 1969)].” See page 2 of the Office Action. Applicants find no such “holding” in *Nerwin*.

Nerwin is an interference case where the parties disputed whether a single structure could be construed as providing support for separate elements of the claimed invention, namely, whether a guide member could provide support for both a “divider” and a “means for directing.” *Nerwin* mentions that “[t]he mere fact that a given structure is integral does not preclude its consisting of various elements.” *Id.* at 179. This statement does not stand for the proposition the Examiner asserts. Instead, it means that an integral structure can provide support for two separate claim elements. Nowhere does *Nerwin* state that constructing an integral structure in various elements involves only routine skill in the art.

In addition, while M.P.E.P. § 2144.04(V)(C) discloses that separating two structures may require only routine skill in the art, that M.P.E.P. section relies only on *In re Duhlber*, 289 F.2d 522, 523 (CCPA 1961). In that case, the structure was not originally an integral one-piece construction.

Moreover, M.P.E.P. § 2144.04 begins by stating that “[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.” Throughout the specification, Applicants describe the criticality of a cutting portion separate from a holder and therefore a means to connect them. For example, in paragraphs [0034] and [0035] of the published application.

Accordingly, as *Nerwin* was inappropriately applied, and Section 2144.04 does not support the Examiner’s proposition, the Section 103(a) rejection of independent claims 1 and 26 should be withdrawn.

2. **There is no motivation to combine the Paternuosto and Jaeger references**

Page 3 of the Office Action contends Jaeger discloses the feature of a protrusion on a cutting portion. Jaeger discloses a surgical instrument 16 including jaw blades 64 removeably attached to a pair of jaws 34, 36. See col. 2, lines 33-36 of Jaeger. Specifically, Jaeger discloses that blade 64 has a lip 66 which fits into slot 52 in jaw 34 or 36 so as to mount blade 64 to jaw 34 or 36. See col. 4, lines 59-63 of Jaeger. The Office Action asserts that Jaeger teaches “mak[ing] the blade removeable for the purpose of sharpening the blade and then replacing it.” See page 3 of the Office Action. Therefore, the Office Action contends “[i]t would have been obvious to one of ordinary

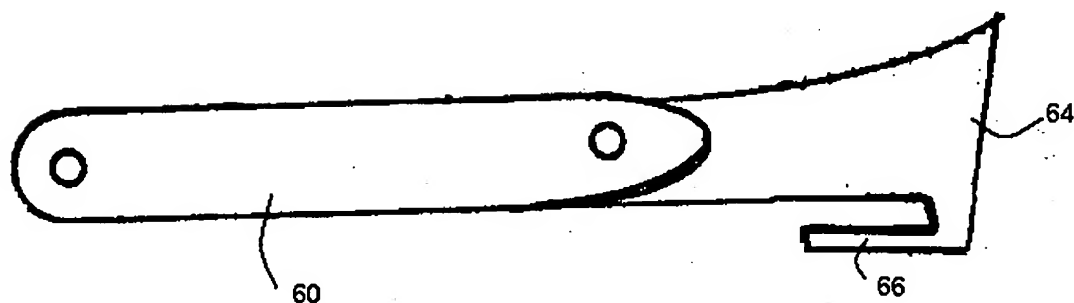
skill in the art to modify the device of Paternuosto with the removeable blade of Jaeger' 669 so that it too has this advantage." See page 3 of the Office Action.

In summary, the Office Action proposes making rim 12 and half-shell 10b of Paternuosto separate elements, and modifying rim 12 to include lip 66 of Jaeger to fit into a groove of half-shell 10b. Yet, the Office Action, makes no clear articulation as to how one skilled in the art would construct that modified device. Nonetheless, for at least the reasons described below, Applicants contend that there is no motivation for one skilled in the art to make the proposed hypothetical modifications to the Paternuosto device.

a. **The alleged groove of Paternuosto is unable to accept the protrusion of the Jaeger device**

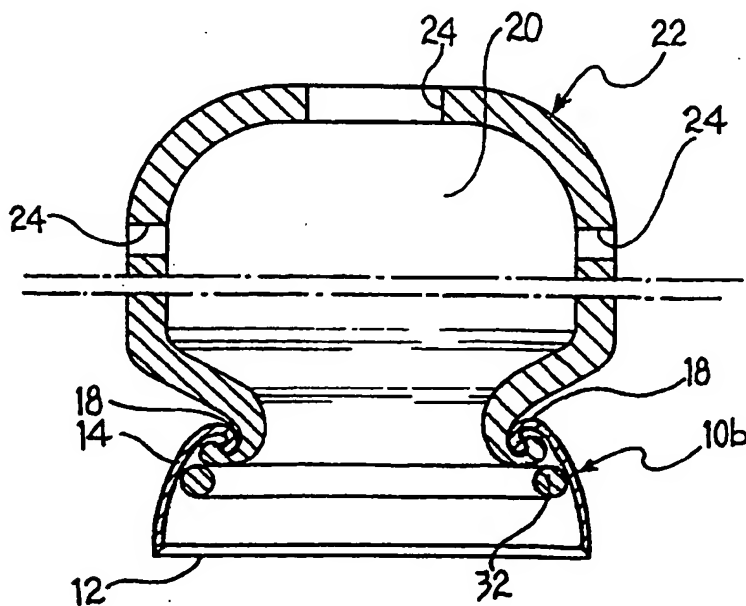
One of ordinary skill in the art would not be motivated to modify rim 12 to include lip 66 of Jaeger, because the alleged groove of Paternuosto would be unable to accept the structure of the Jaeger protrusion.

Jaeger teaches that the lip 66 shown in Fig. 5 is located at the front end of blade 64 and extends from its non-cutting side. See col. 4, lines 59-63 of Jaeger. Applicants have included a left-side view of Fig. 5 (i.e., the bottom blade 64 in its frame to be inserted into a jaw). As shown in the left-side view of Fig. 5, lip 66 curls beneath blade 64 and extends back toward frame 60, *so as to be parallel to the longitudinal axis of blade 64.*



In contrast, the depth of the groove formed by the hole in base wall 14 is vertical relative to the longitudinal axis of front rim 12. This is best seen in Figure 9 of Paternuosto, reproduced below.

FIG. 9



It is not understood then how the proposed hypothetical modification to the Paternuosto device can actually be executed in view of, for example, the structures of the Jaeger and Paternuosto devices. The very position of the alleged groove of

Paternuosto appears unable to accept any protrusion parallel to the longitudinal axis of rim 12 of Paternuosto.

b. There is no motivation to modify the Paternuosto device to accept a protrusion on the front rim

Furthermore, even if the protrusion were directed at the alleged groove (i.e., the lip within the perimeter of the hole in base wall 14), the protrusion would interfere with the attaching mechanism i.e., spring ring 32, between storage container 22 and half-shell 10b. Substantial modification of Paternuosto device, including the removal of ring 32 would be necessary for the protrusion to be received by the alleged groove. Spring ring 32, however, is a required design feature of the Fig. 9 embodiment of Paternuosto. As explained on page 6, paragraph 1 of Paternuosto, spring ring 32 is placed above engaging portions of base wall 14 and beaker-shaped container element 22 to apply a compressive force and maintain the engagement of beaker-shaped container element 22 and the rim of the complementary shaped hole 18. Since spring ring 32 is a necessary feature of the Figure 9 embodiment of Paternuosto, one skilled in the art would not be motivated to make that substantial modification. Accordingly, there exists no motivation to modify the Figure 9 embodiment of Paternuosto to somehow include the feature of a protrusion being received by the alleged groove of Paternuosto.

For at least these reasons outlined above, Applicants respectfully request that the Section 103(a) rejected of independent claims 1 and 26 be withdrawn.

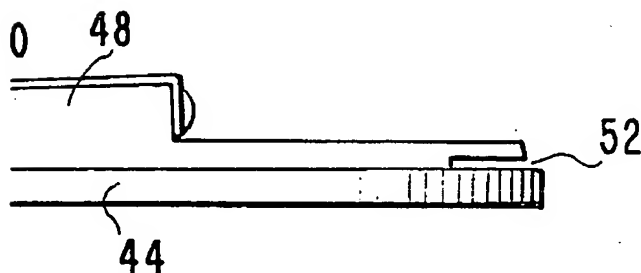
Claims 2, 6-25, 27, 31-49, 87, and 89 are allowable at least due to their dependency from one of independent claims 1 and 26. In addition, each of these claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

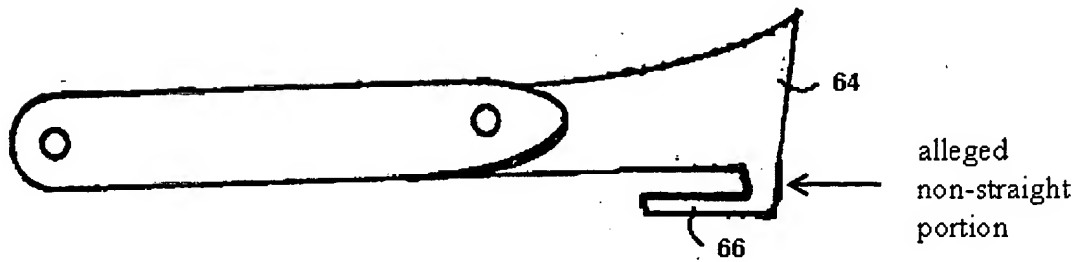
B. Independent claim 50

Independent claim 50 recites an endoscopic instrument comprising, among other things, "wherein the cutting portion has a non-straight portion connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder."

Page 3 of the Office Action appears to acknowledge that Paternuosto does not disclose an end effector having a non-straight portion connecting a tang to a cutting edge and received in a correspondingly-shaped gap in the holder. The Office Action, however, relies on Jaeger for the alleged teaching of a "non-straight portion (Figure 5) connecting a tang (66) to a cutting edge (64)." See page 3 of the Office Action. Even assuming that the portion connecting lip 66 to jaw blade 64 corresponds to the claimed "non-straight portion," which Applicants do not concede, the shape of slot 52 does not correspond to the portion connecting lip 66 to jaw blade 64. In fact, slot 52 is perpendicular to the alleged non-straight portion and therefore cannot receive the alleged non-straight portion. This is clearly shown in the enlarged view of Fig. 4 of Jaeger and the left side view of the blade and frame of Fig. 5, reproduced below, where slot 52 and the alleged non-straight portion of lip 66 have been identified.

FIG. 4.





Accordingly, the combination of Paternuosto and Jaeger fails to disclose at least the claimed combination including “a holder configured to receive the second end effector, wherein the second end effector has a non-straight portion connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder,” as required by independent claim 50.

Applicants respectfully request the reconsideration and withdrawal of the Section 103(a) rejection of independent claim 50.

Claims 52-65, 89, and 90 are allowable at least due to their dependency from independent claim 50. In addition, each of these claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

C. Independent claim 91

Though independent claim 91 was rejected under Section 103(a) as being obvious over Paternuosto in view of Jaeger, the Examiner did not address the claim. In fact, in explaining the rejection on page 3, the Examiner points to: (1) the subject matter of independent claim 50; and (2) the subject matter of Jaeger relating to an alleged non-straight tang. As pointed out on pages 6 and 7 of the Reply to Office Action filed on October 16, 2008 and reiterated here, the scope of independent claim 91 differs from

that of independent claim 50 and does not include a “non-straight tang.” Applicants therefore are unclear if the Examiner intended to reject independent claim 91 over the combination of Paternuosto and Jaeger.

Further, no combination of Paternuosto and Jaeger discloses or suggests independent claim 91. Independent claim 91 recites an end effector assembly for obtaining multiple tissue samples comprising, among other things, “wherein the holder is configured to receive the cutting portion and the storage portion, wherein a protrusion or a recess on the cutting portion is configured to mate with a recess or a protrusion on the storage portion.” No combination of Paternuosto and Jaeger discloses or suggests at least this aspect of independent claim 91 either alone or in combination with other aspects of independent claim 91. Indeed, these recitations are not addressed at all in the Office Action.

Though page 2 of the Office Action asserts that “[t]he holder portion [in Paternuosto] has a groove shown in fig. 9 for receiving a lip on the storage portion,” Fig. 9 of Paternuosto does not disclose that the rim 12 mates with the storage portion lip. Moreover, Jaeger does not cure the deficiency in such a way such that their combination would have rendered the present invention obvious.

For at least these reasons, the combination of Paternuosto and Jaeger fails to render the subject matter of independent claim 91 unpatentable. Should the Examiner persist in the rejection, Applicants request that the Examiner specifically address independent claim 91.

Accordingly, Applicants respectfully request the reconsideration of independent claim 91 and that the Section 103(a) rejection of independent claim 91 be withdrawn.

Claims 92-94 depend from independent claim 91. In addition, each of these claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

III. New Claims

New claims 95-103 are allowable at least due to they dependency on one of independent claims 1, 26, and 50. In addition, each of claims 95-103 recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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